REMARKS

Claims 51 and 52 are currently pending. Claims 51 and 52 have been amended. Claims 2-25, 46 and 55-57 have been canceled without prejudice. Applicants reserve the right to prosecute any canceled subject matter in one or more divisional, continuation or continuation-in-part applications. No new matter has been added.

Rejections Under 35 U.S.C §112, First Paragraph

The Examiner has rejected claims 46, 51, 52 and 55 under 35 U.S.C. §112, First Paragraph, as allegedly failing to comply with the written description requirement.

Claims 46 and 55 have been canceled without prejudice, thus rendering moot the rejection of these claims.

Specifically, the Examiner alleges that while the specification supports the combination of the use of compounds of formula I and at least one H1 antagonist, there is no antecedent basis for a single composition with two specific active ingredients.

Applicants respectfully disagree and contend that the instant specification as filed provides support for both a composition comprising compound 32 and loratadine or descarboethoxyloratadine, and for methods of treating various conditions comprising administering compound 32 and loratadine or descarboethoxyloratadine.

Claim 51 has been amended to recite a pharmaceutical composition comprising an effective amount of compound 32, an effective amount of loratadine or descarboethoxyloratadine, and a pharmaceutical carrier.

Applicants invite the Examiner's attention to claim 51 as originally filed in U.S. Application No. 09/978267 (the "267 application," which issued on April 13, 2004 as US Patent No. 6270328) to which the instant application is a division of and claims priority to. Claim 51, as filed in the '267 application, sets forth a composition comprising one of only five depicted chemical species with an H1 antagonist and if not for the species election required by the Examiner in connection with the instant application, presently pending claim 51 would find support in claim 51 as originally filed in the '267 application. Further, the instant specification at page 16, lines 7-9 clearly set forth that a particular embodiment of the invention "is directed to a

pharmaceutical composition comprising an effective amount of a compound of claim 32, an effective amount of an H1 receptor antagonist, and a pharmaceutically effective carrier." The specification also specifically recites at sets forth at page 11, lines 12-14 that loratadine and descarboethoxyloratadine are representative H1 antagonists useful in the pharmaceutical compositions of the invention. Finally, at page 12, lines 8-13, the specification refers to specific embodiments of the invention wherein a compound of formula I (which encompasses compounds 32) is combined with loratadine or descarboethoxyloratadine. Accordingly, applicants believe that taken together, these sections of the disclosure clearly provide support for presently pending claim 51.

With respect to the Examiner's allegation that claim 52 is not supported by the specification, applicants point out that presently amended claim 52 is directed to a method for treating allergy, allegy-induced airway responses or congestion comprising administering compound 32 and either loratadine or descarboethoxyloratadine. Applicants invite the Examiner's attention to the instant specification at page 20, lines 14-18, which clearly provides support for presently pending claim 52.

Accordingly, applicants believe that the rejections of claims 51 and 52 under 35 U.S.C. §112, First Paragraph, have been overcome and should be withdrawn.

Rejections Under 35 U.S.C §112, Second Paragraph

The Examiner has rejected claims 46, 51, 52 and 55 under 35 U.S.C. §112, Second Paragraph, as allegedly failing to comply with the enablement requirement.

Claims 46 and 55 have been canceled without prejudice, thus rendering moot the rejection of these claims.

Specifically, the Examiner alleges that while the specification does not support a specific single combination of a compound of the invention and an H1 receptor antagonist. The Examiner also alleges that the instant specification neither provides a procedure for measuring Ki nor actual Ki values for any compound. Finally, the Examiner alleges that no clinical trial data was disclosed for a combination and that no information was provided on how to form a single dosage unit of a compound of formula I with loratadine or descarboethoxyloratadine.

Claim 51 has been amended to recite a pharmaceutical composition comprising compound 32 with loratadine or descarboethoxyloratadine and a pharmaceutical carrier.

Applicants invite the Examiner's attention to the instant specification at page 128, line 26 to page 129, line 13, wherein a detailed method is set forth for determining the Ki of the compounds of the invention. In addition, at page 129, line 25, it clearly states that the Ki of compound 32 is 0.83 nM, which easily falls under th 200 nM threshold established in the Korte et al. reference, which was cited by the Examiner as a measuring stick for suitable activity for an H3 antagonist clinical candidate. Further, the specification teaches methods for making pharmaceutical compositions at page 129, line 28 to page 131, line 9, wherein various dosage forms and dosages are disclosed, as is a reference to *Remington's Pharmaceutical Sciences* at page 180, lines 3-5. The information provided in this section of the specification in conjunction with the disclosure of *Remington's Pharmaceutical Sciences*, would easily allow one of ordinary skill in the art of formulation science to formulate compositions comprising compound 32 with either loratadine or descarboethoxyloratadine without undue experimentation. Finally, applicants contend that clinical trial data is not a pre-requisite for enablement under 35 U.S.C. §112, Second Paragraph.

Accordingly, applicants believe that the rejections of claims 51 and 52 under 35 U.S.C. §112, Second Paragraph, have been overcome and should be withdrawn.

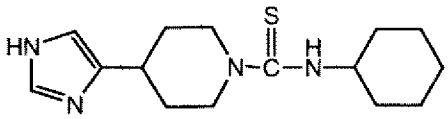
Rejections Under 35 U.S.C. §103(a)

The Examiner has rejected claims 46, 51, 52 and 55 under 35 U.S.C. §103(a) as allegedly being obvious over US Patent No. 5,869,479 to Kreutner et al. ("Kreutner").

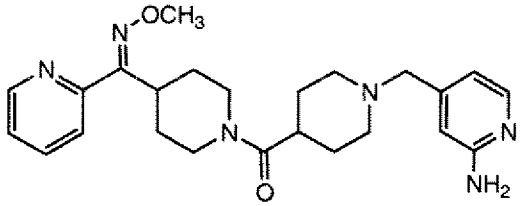
Claims 46 and 55 have been canceled without prejudice, thus rendering moot the rejection of these claims.

Specifically, the Examiner contends that Kreutner discloses a method for screening and testing H_3 receptor antagonist compounds and that Kreutner also discloses a combination of loratadine or descarboethoxyloratadine with the specific H_3 antagonist, thioperamide. The Examiner further contends that the only difference between the instant claims and Kreutner is that Kreutner discloses compositions comprising thioperamide instead of compound 32 of the instant application, which is the lone compound being claimed in the composition of claim 51 and method of claim 52 of the instant claims. Applicants contend that the difference between the chemical

structures of thioperamide and compound 32 is vast, as indicated in the side-by-side depiction of the chemical structures below.



thioperamide



Instant Compound 32

Applicants further contend that there are no teachings or suggestions in Kreutner that would motivate one of ordinary skill in the art of medicinal chemistry to arrive at a composition comprising or a method employing compound 32 based on the disclosure of a composition or method which uses a compound having a chemical structure that is not at all similar to compound 32.

Accordingly, applicants believe the rejection of claims 51 and 52 under 35 U.S.C. §103(a) has been overcome and should be withdrawn.

Obviousness Type Double Patenting

The Examiner has rejected claims 46, 51, 52 and 55 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 6-8 of Kreutner in view of US Patent Publication No. 2004/0198743 (the "'743 publication")

Claims 46 and 55 have been canceled without prejudice, rendering moot the rejection of these claims.

Specifically, the Examiner contends that the only difference between the instant claims and Kreutner is that Kreutner discloses compositions comprising thioperamide instead of compound 32 of the instant application, which is the lone compound being claimed in the composition of claim 51 and method of claim 52 of the instant claims. The Examiner further alleges that the '743 publication provides evidence that compounds of similar chemical structure to compound 32 of instant claims 51 and 52 are alternative choices for the compositions taught in Kreutner.

Applicants respectfully remind the Examiner that an obviousness-type double patenting rejection must be based on the obviousness standard of 35 U.S.C. 103(a). MPEP section 1504.06. Accordingly all art cited by the Examiner against the instant application in support of such a rejection must be relevant *prior art*. The '743 publication has a publication date of October 7, 2004, which is clearly later than the

October 17, 2000 priority date of the instant application. Thus, the '743 application is not prior art to the instant claims and, as such, cannot be used as a basis for an obviousness-type double patenting rejection.

Accordingly, Applicants believe that the Examiner's rejection of claims 51 and 52 on the ground of nonstatutory obviousness-type double patenting over claims 1-3 and 6-8 of Kreutner in view of US Patent Publication No. 2004/0198743 cannot stand and must be withdrawn.

If the undersigned can be of any assistance to the Examiner in addressing issues to advance the application to allowance, please contact the undersigned at the number set forth below.

June 4, 2007

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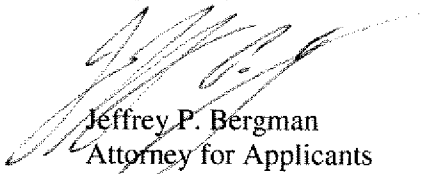
Respectfully submitted,



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